

REMARKS

Claims 1-4, 9, 10, 12-14, 19-40, 45-49, 52, 54, 56, 65, 66, 70, 74, 76, and 77 are pending.

Claims 80-84 have been added. Claims 1, 9, and 50 have been rewritten to correct minor
5 typographical errors. The specification has been amended to correct the priority claim of this application.

Applicant has included a credit card payment form for \$1190.00. This amount includes the large entity fee (\$420.00) for a two-month extension of time and the fee for a request for continued examination (\$770.00). Applicant does not believe that any other fees are due at this
10 time; however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to this document, the Commissioner is authorized to deduct the fees from Ian F. Burns & Associates, P.C. Deposit Account No. 50-0913.

REJECTION UNDER 35 U.S.C. §103(a)

15 The Office rejected claims 1-4, 9, 10, 12-14, 19-40, 45-50, 52, 54, 56, 65-66, 70, 74, 76, and 77 under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent 6,224,483 to Mayeroff (hereinafter, "Mayeroff") in view of one or more of Great Britain Patent GB 2,320,206 to Stanley (hereinafter, Stanley), U.S. Patent 6,270,412 to Crawford et al. (hereinafter, Crawford), and Japanese publication JP05285252 to Kaku (hereinafter, Kaku).

20 All of the rejections rely on the Office's interpretation of the alleged teachings of Stanley. However, Applicant respectfully disagrees with the Office's characterization of Stanley and notes that Stanley does not meet the limitations of Applicant's claims.

The Declaration of Loren Nelson Supports Applicant's Arguments and has Not Been Rebutted
by the Office

In support of Applicant's previous response, Applicant submitted the declaration of an expert in the gaming art, Mr. Loren Nelson. It appears that the Office discounted Mr. Nelson's statements because he is an employee of the assignee of the present application (and therefore Applicant assumes the Office is suggesting that Mr. Nelson's statements are tainted by bias) and because Mr. Nelson states his opinions rather than providing facts. See pages 7-9. Applicant respectfully disagrees with the Office's characterization of Mr. Nelson's affidavit.

First, although the Office apparently questions Mr. Nelson's credibility, the Office pointed to nothing to indicate that Mr. Nelson's opinions were incorrect, unreasonable, or in any way tainted. Second, Mr. Nelson has over 11 years of experience in the gaming art, including game design, and the Office did not challenge that he is an expert in this field. Applicant believes that Mr. Nelson's expert opinions, by themselves, provide support for Applicant's assertions.

Applicant fears that the Office is seeking facts and evidence that may be impossible to gather. For example, Mr. Nelson estimated that it would take 1.5 man years for the ordinary artisan to build a gaming machine of the type recited in the Stanley Abstract. The Office discounted this expert opinion because "There is no documentary support evidence provided for how this conclusion was reached or what, if any, equations were used." Page 8. Applicant is unaware of a methodology to provide what the Office is seeking.

Stanley Does Not Teach a Second Game of *Chance*

Applicant's review of Stanley leads Applicant to believe that Stanley purports to suggest a first game of chance. Upon the occurrence of a predetermined outcome in the first game of chance, the player may be given the opportunity to play a second game. Stanley specifically and

repeatedly states that this second game is a “game of skill”. (see paragraphs 6-8 and 10 of the description).

Further review of Stanley reviews that this “game of skill” is a ball game. *See* paragraphs 10, 20-25, and figure 1. According to Stanley, a ball is released onto a pin table having a sloping floor. *See* paragraph 20. On the floor are a number of holes representing various prizes or game events. *See id.* When activated, the player tries to influence the outcome of the second game—a skill game—by using skill to direct the ball into a desired hole. *See* paragraph 22. The player “bangs” on the side of the skill table to influence that ball’s trajectory. *See id.* However, the player must also be careful because too much banging will cause a tilt switch to activate. *See id.*

Stanley simply does not meet the limitations of Applicant’s claims. Applicant does claim a second game that is activated in response to the occurrence of a predetermined outcome in a first game of chance. However, unlike Stanley, Applicant specifically discloses and claims that the second game is a game of chance. The Office repeatedly misstates that Stanley teaches a second game of chance. Pages 3, 4, and 10. It does not. Because Stanley does not disclose a second game of chance, it does not meet the limitations of Applicant’s claims.

No other reference has been cited as meeting this limitation. Because the combination of references cited by the Office does not teach or suggest all elements of Applicant’s claims, as required by MPEP § 2142, the combination cited by the Office does not render Applicant’s claims obvious. Applicant notes that Applicant is not trying to overcome a §103(a) rejection by attacking references individually. Rather, nothing in the asserted combination of references teaches an element of Applicant’s claim. However, there are additional reasons why Applicant’s claims are patentable over the cited combination.

Stanley Does Not Teach Replay of the First Game of Chance

A limitation of claim 1 is that the second game of chance has an outcome that allows the player to replay the first game of chance. The Office alleged that Stanley teaches playing a first game of chance, obtaining an outcome that allows play on a second game of chance (which it does not), and obtaining an outcome that allows additional play on the first game of chance. 5 Page 3. The Office's support for this conclusion appears to be one sparse statement in Stanley's abstract that states "successful completion of the pinball game leading to a further game on the fruit machine." *See id.* The abstract of Stanley does not suggest that the additional game on the fruit machine is the same as the original game on the fruit machine. Applicant respectfully 10 submits that the Office's interpretation of Stanley is excessively broad and not substantiated by the actual content of the Stanley patent.

Stanley does not appear to contemplate an outcome of the second game that allows play of normal, additional game rounds on the first game. Rather, the only additional play apparently suggested by Stanley is the well known "nudge" feature by which a player can move a reel up or 15 down in order to obtain or improve a winning outcome. *See* paragraph 23. Applicant asserts that the nudge feature is not the same as re-playing the first game.

The nudge feature modifies a previous game outcome while a re-play generates a new game outcome. The player controls whether, how, and how much to nudge a particular reel- therefore, there is no replay of a game of chance because the outcome of the nudge is not left to 20 chance. The nudge feature does not meet the limitations of Applicant's claims that specify that the second game have a random outcome.

Although a drawing in Stanley depicts a hole entitled "spin a win," there is absolutely no description of this feature in the specification. *See* figure 4. The Office speculated that this meant that that the fruit game is replayed until a win is obtained. Pages 3-4. However,

Applicant respectfully asserts that there is no basis for this assumption in the specification itself.

Applicant respectfully asserts that a reference cannot be made enabling by the Office's creation of a disclosure that is simply not there.

Even assuming that the "spin a win" feature operates in the manner suggested by the Office, this feature would not be "re-playing" the first game because the rules of the first game are no longer the same because a losing outcome only means additional spins will be needed until it is determined what the player's prize will be. The player is guaranteed to win some prize, unlike a normal game round of the first game. Like the "nudge" feature, even if "spin a win" functioned as asserted by the Office, it does not constitute replaying the first game of chance because "spin a win" does not have a random outcome.

No Legitimate Motivation Has Been Shown to Combine the Individual References into the Asserted Combination

In addition to failing to disclose all elements of Applicant's claims, Applicant again respectfully asserts that the Office has not provided a legitimate motivation for combining the references used to reject Applicant's claims. The Office stated that it would be obvious to combine Stanley and Mayeroff because:

By incorporating an apparatus that provides the user with a higher anticipation of an award and greater excitement [Stanley], the lure of the machine is greatly increased and the goal of the gaming industry is met as the slot machine is more exciting to play and this more likely to be played and generate revenues. For these reasons, it would have been obvious to one skilled in the art at the time of invention to incorporate the bonus round teachings of Stanley into the apparatus of Mayeroff to create a game of chance where the bonus round is more exciting and enticing to the user.

The Office has stated only the most general goal underlying the creation of gaming devices. Of course, all designers try to create games that will excite and interest players. It would, indeed, be curious if game designers deliberately tried to create boring, uninteresting, and unenjoyable games. Applicant respectfully asserts that the general goal of making exciting, interesting, and enjoyable games does not provide any specific motivation for one of skill in the art to combine Mayeroff and Stanley. This reason does not even guide one of skill in the art in the general direction of making the combination.

If sufficient, the Office's motivation would allow any gaming reference to be combined with any other gaming reference merely because they were all trying to achieve the same general goal. However, Applicant does not believe that the Office's stated reason for combining Stanley and Mayeroff comports with the appropriate legal standard. The Office has cited only a general motivation, a motivation that would be as likely to cause one of skill in the art to combine Stanley with any of a nearly infinite number of other gaming references. This amounts to nothing more than a statement that it would be "obvious to try" combining Stanley with Mayeroff in hopes that a successful game might result. However, both the MPEP and federal case law make it clear that "obvious to try" is not a suitable basis for denying a patent. *See* MPEP §2145(X)(B).

For example, MPEP §2145(X)(B) states that an improper "obvious to try" test may be used "In some cases [where] what would have been 'obvious to try' would [be] to vary all parameters or try each of numerous possible choices until one possibly arrives at a successful result...." *See also In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988). The Federal Circuit has held that the evidence supporting a suggestion, teaching, or motivation to combine "must be clear and particular." Said the Court, "Broad conclusory statements regarding the teaching of multiple

references, standing alone, are not ‘evidence...,’” of a motivation to combine references and support a §103(a) rejection. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

The only potential motivation to combine Stanley and Mayeroff comes from the blueprint supplied by Applicant. However, this is impermissible hindsight reconstruction. *See* MPEP
5 §2145(X)(A). The Federal Circuit has made it clear that the Office should be particularly careful in avoiding hindsight reconstruction “in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.’” *Dembiczak*, 175 F.3d at 999. “[T]he best defense against the subtle
10 but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *See id.*

The Federal Circuit has repeatedly warned against making findings of obviousness based on hindsight reconstruction. The Federal Circuit has noted that “virtually all [inventions] are combinations of old elements.” *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (internal
15 citation omitted). Indeed, the Federal Circuit cautioned that:

An examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an
20 examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.”

25 *Id.* (internal citation omitted).

Applicant believes that the combination of Mayeroff and Stanley with Crawford and/or Kaku supports the argument that the Office’s combination is contingent on hindsight reconstruction. Notably, the Office stated that it would be obvious to combine the symbol save

feature of Crawford with Mayeroff and Stanley because “the user would get even more enjoyment out of the bonus round”, therefore potentially making the game more successful and thereby generating more revenue. The Office is using the same general motivation to pick and choose among disparate references in order to find a combination of references that allegedly
5 discloses all elements of Applicant’s claims. Applicant sees nothing in Crawford that suggests combining a concentric wheel bonus game with a symbol save feature, as opposed to any of the vast array of improvements that have been devised for gaming devices.

The Office stated that it would have been obvious to include Kaku in the asserted combination because: “[T]he user would enjoy the bonus round more...[t]his would provide
10 more enjoyment to the user...[and t]herefore it would have been obvious...” to combine Kaku with Mayeroff, Crawford, and Stanley. *See* page 7. Again, only a very general motivation was provided—all games are intended to be enjoyable. Like the other motivations suggested by the Office, it amounts, at most, to “obvious to try” and cannot justify a §103(a) rejection.

Applicant previously expressed concern over the number of references relied upon for the
15 §103(a) rejections. The Office stated that “reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention,” and cited MPEP §2145(V). While the Office’s statement may be true, Applicant respectfully suggests that the more references that are combined, the more care must be used to avoid hindsight reconstruction. With all respect to the Office, Applicant is concerned that the general motivation
20 of “creating more exciting games” or “increasing player enjoyment” cannot be used to cobble together disparate references into a supportable obviousness rejection.

CONCLUSION

Because insufficient motivation to combine the references used in the 103(a) rejection has been provided, and because the asserted combination fails to teach all elements of the claims,

Applicant respectfully requests the Office to withdraw the § 103(a) rejection of claims 1-4, 9, 10, 12-14, 19-40, 45-50, 52, 54, 56, 65-66, 70, 74, 76, and 77. In addition, Applicant suggests that new claims 80-84 are allowable over the art of record for the reasons discussed above.

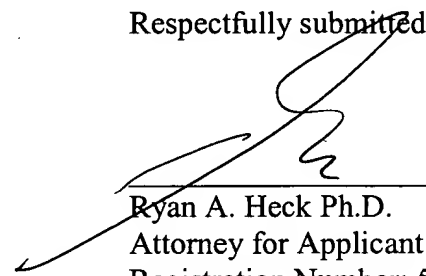
Applicant submits that the present application is in condition for allowance. If the
5 Examiner has any questions regarding the application or this Amendment D, the Examiner is encouraged to call the Applicant's attorney, Ryan A. Heck, at (775) 826-6160.

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Respectfully submitted,



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